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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,237	03/20/2000	Seth D. Rose	344-P-16-USA	9691

7590 04/29/2004

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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,237

Applicant(s)

ROSE ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time and amendment and remarks filed 01/16/04. Claim 9 is pending.

Claim Rejections - 35 USC § 103

1. Claim 9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. (US 4,826,677).

Applicants argue that Mueller does not disclose a water-soluble polymer and hydrophobically modified polymer that are both soluble in the volatile solvent and the modified polymer that is insoluble in water so that a tightly adherent film forms on the body tissue, "which is not dissolved or displaced by body fluids, such as blood, perspiration, saliva, etc. all of which are water based."

Applicants further state that "Mueller's compositions form 'non-stick films' on body tissues after the solved 'such as water or alcohols' evaporate. (Mueller, Col. 3, lines 33-44)."

2. Applicants' arguments filed 01/16/04 have been fully considered but they are not persuasive.

Mueller discloses polyvinyl alcohol and polyvinyl acetate and their copolymers (column 2, lines 55-57) and by this suggestion/disclosure, a poly(vinyl alcohol-co-vinyl acetate) copolymer is contemplated. Poly(vinyl alcohol-co-vinyl acetate) is water soluble per instant claim 9. Therefore, Mueller discloses water-soluble polymers. The antipsoriatic medicine, vitamin A is a hydrophobic compound having a hydrophobic group. When the composition of Mueller is applied to the skin and forms a film after the solvent evaporates, Mueller discloses in

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examples 1 and 2 that the film adheres well to the skin and the formed film is removable by simply pulling the film off.

Thus, although column 3, lines 36 and 37 of Mueller disclose the formation of non-stick films or foils, it is respectfully noted as disclosed in examples 1 and 2 that the film adheres to the skin. Sticky or non-sticky is a degree of tackiness, which is not defined in the claims. In instant claim 9, the film adheres to body tissue. Mueller discloses adherence of the film to skin, which is a body tissue. It is also respectfully noted that the mere application of a composition to a substrate meets the limitation of the requirement for adherence.

It is further noted that it is well known for a coating to be formed on a substrate upon application of a coating composition. The coating does not have to be permanent but may be transitory and non-permanent in nature.

The Examiner interprets the claims as requiring a copolymer of polyvinyl alcohol and polyvinyl acetate and considers the scope of this term to require covalently bonded monomers. Hence a rejection under 35 USC 102 was contemplated but deemed inappropriate in view of this reasonable interpretation of *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994). The reference fails specifically to direct one of ordinary skill in the art to the copolymer claimed from among the various and multiple polymers claimed.

The rejection is thus maintained.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

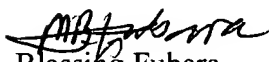
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 242-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Blessing Fubara
Patent Examiner
Tech. Center 1600